

REMARKS/ARGUMENTS

Reconsideration and allowance of this application are respectfully requested.

Currently, claims 1-32 are pending in this application.

Request to Fully Initial Form PTO-1449:

Applicant has received a (partially-initialed) copy of the Form PTO-1449 which was filed on October 9, 2001. However, the reference “Nintendo, ‘99 Source Book’, May 1999” was not initialed as being considered. Applicant thus respectfully requests that this Form PTO-1449 be fully initialed as an indication that all of the cited references have been considered. For the Examiner’s convenience, a copy of the returned Form PTO-1449 is attached hereto.

Rejection Under 35 U.S.C. §101:

Claims 1-24 were rejected under 35 U.S.C. §101 “because they do not apply, involve, use, or advance the technological arts.” Applicant respectfully traverses this rejection.

There is no “technological arts” test to determine patent eligible subject matter under 35 U.S.C. §101 as alleged by the Office Action. For example, the Board of Appeals and Interferences at the U.S. Patent Office has issued the Precedential Opinion *Ex parte* Carl A. Lundgren (Appeal No. 2003-2088 in application no. 09/093,516; copy attached) states the following:

“Our determination is that there is current no judicially recognized separate ‘technological arts’ test to determine patentable eligible subject matter under §101. We decline to create one. Therefore, it is apparent that the examiner’s rejection cannot be sustained.” (*Ex parte* Carl A. Lundgren, page 7).

Accordingly, the Office Action's rationale that claims 1-24 is not directed to statutory subject matter under 35 U.S.C. §101 "because they do not apply, involve, use or advance technological arts" is fundamentally flawed.

In an abundance of caution, claims 1-24 have been amended to require "A computer-implemented method...." Accordingly, it is even more clear that claims 1-24 are directed to statutory subject matter under 35 U.S.C. §101. Accordingly, Applicant respectfully requests that the rejection of claims 1-24 under 35 U.S.C. §101 be withdrawn.

Rejections Under 35 U.S.C. §102 and §103:

Claims 1-12, 14, 15, 17, 18, 20, 21, 23 and 24 were rejected under 35 U.S.C. §102(a) as allegedly being anticipated by Acer America's "Channel Forum" website (hereinafter "the Channel Forum website").¹ Claims 13, 16, 19 and 22 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over the Channel Forum website. Applicant respectfully traverses these rejections.

From the outset, it is noted that claim 13 is rejected under 35 U.S.C. §103 over the Channel Forum website, but that claims 14-15 which depend from claim 13 are rejected under 35 U.S.C. §102 as allegedly being anticipated by the Channel Forum website. Applicant submits that dependent claims 14-15 further limit base independent claim 13, and thus it is not understood how claims 14-15 can possibly be anticipated by the Channel Forum website, when base independent claim 13 is merely rejected under 35 U.S.C. §103 as being "obvious".

Similarly, it is not understood how claim 17 can be anticipated by the Channel

¹ Applicant notes the Examiner's allegation that these websites were dated 11/08/1999 and 03/09/2000.

Forum website, when the Office Action merely alleges that base independent claim 16 is “obvious” under 35 U.S.C. §103 over the Channel Forum website. Similar comments apply to claims 20-21 (rejected under 35 U.S.C. §102) with respect to base independent claim 19 (rejected under 35 U.S.C. §103) as well as dependent claims 23-24 with respect to base independent claim 22. Applicant thus respectfully requests clarification.

For a reference to anticipate a claim, each element must be found, either expressly or under principles of inherency, in the reference. Each element of the claimed invention is not found in the Channel Forum website. For example, the Channel Forum website fails to disclose a webpage displaying the amount of credit already available to the user for its marketing activities as required by independent claims 1 and 7.

Instead of providing a webpage for displaying the amount of credit available to the user for its marketing activities, the Channel Forum website states “Statements are mailed quarterly to each reseller directly.” (See page 3 under the heading “Accruals”).

The Office Action alleges that page 9 of the Channel Forum website discloses the above-noted claim limitation. Applicant respectfully disagrees. Page 9 states “Please complete all of the enrollment information below and begin by earning 1,000 points just for enrolling.” Page 9 thus merely provides information that the user may, in the future, earn 1,000 points for enrolling. The information disclosed on page 9 does not indicate to the user the amount of credit that is available to the user. Indeed, the user will have to fill in and submit the enrollment form illustrated on page 9, and Acer Advantage will have to confirm this enrollment before even awarding the 1,000 points. In the Acer program, the user is informed of accruals via a quarterly statement which is physically mailed, not via a website. Page 3 of the Channel Forum website stating “Statements are mailed quarterly...” thus teaches away from the invention required by claims 1 and 7.

With respect to claims 5, 11, 14, 17, 20 and 23, section 7 of the Office Action alleges that page 13 of the Channel Forum website discloses tasks performed by the user to earn bonus credit comprising advertising a certain item during a predetermined time period. Applicant submits that this allegation results from a mischaracterization of page 13. Page 13 is an advertisement to the user. This advertisement to the user does not have anything to do with the user advertising a certain item during a predetermined time period, let alone doing so to earn bonus credit. The only credit discussed in the Channel Forum website is based upon reseller's net purchases and returns.

With respect to claims 6, 12, 15, 18, 21 and 24, section 8 of the Office Action alleges that page 4 of the Channel Forum website discloses tasks performed by the user to earn bonus credit comprising advertising a certain item for at least a predetermined price. Applicant respectfully disagrees with this characterization of page 4. Page 4 discusses how funds can be spent by a user on standard or prior approval activities. Page 4 has nothing to do with how that user may earn credit, let alone earning credit by advertising a certain item for a predetermined price.

With respect to independent claims 13 and 16, the Channel Forum website fails to teach or suggest determining an amount of bonus credit for use by the user to defray costs of its marketing activities, the bonus credit being earned by the user if the user has advertised, merchandised, or promoted a certain item. This bonus credit is in addition to the credit earned which is based on the cost of an ordered item.

The bottom of page 10 of the Office Action states that "merchandising a certain item is taken to mean the same thing as buying, ordering, or purchasing (all synonyms)." Applicant respectfully disagrees. Merchandising (a marketing activity) does not mean the same thing as buying, ordering or purchasing as alleged by the Office Action. Indeed,

page 1, lines 21-25 of the originally-filed specification states “In order to promote such sales, the retailers will often engage in marketing activities such as advertising (e.g., television, radio and printed advertisements), promotions (e.g., sweepstakes, contests, gift with purchase events and in-store events) and merchandising (e.g., displays, in-store signs, posters and banners) (emphasis added).”

Accordingly, the meaning of merchandising is clearly not “the same thing” as buying, ordering or purchasing as alleged by the Office Action. This interpretation by the Office Action also is not consistent with the remainder of the explicit claim language in which non-bonus credit is based on the cost of an ordered item. That is, an amount of non-bonus credit is earned by a user based on the cost of an ordered item, and the bonus credit is earned through marketing activities such as advertisement, merchandising or promotion.

Independent claims 19 and 22 require determining whether a user is entitled to credit by determining whether a user has advertised, merchandised or promoted a certain item. The Channel Forum website fails to teach or suggest this claim limitation. As discussed above, merchandising is a marketing activity which is not synonymous with buying, ordering or purchasing. The Acer Advantage program determines whether a participant is entitled to credit based on the participant’s purchases and returns (and the participant’s reporting thereof), not whether the participant has advertised, merchandised or promoted a certain item.

Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. §102 and §103 in view of the Channel Forum website be withdrawn.

MAIN et al.
Application No. 09/972,191
January 25, 2006

New Claims:

New claims 25-32 have been added to provide additional protection for the invention. Claims 25-26 depend from claims 1 and 13, respectively and are thus allowable for at least the reasons discussed above. New claim 27 requires, *inter alia*, "generating a web page using the data provided to the computer system, the web page displaying the amount of credit currently available to the user for its marketing activities." New claim 30 requires, *inter alia*, "determining an amount of bonus credit also for use by the user to defray costs of its marketing activities, the bonus credit being earned by the user if the user has advertised, merchandised or promoted a certain item."

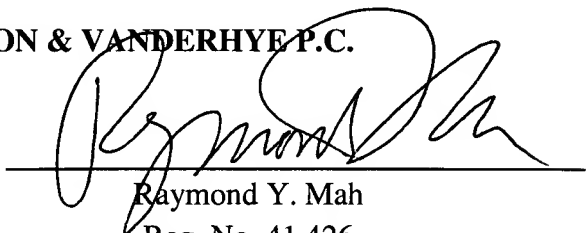
Conclusion:

Applicant believes that this entire application is in condition for allowance and respectfully requests a notice to this effect. If the Examiner has any questions or believes that an interview would further prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____


Raymond Y. Mah
Reg. No. 41,426

RYM:sl
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4044
Facsimile: (703) 816-4100